

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/733,251

Applicant(s)

FISCHER ET AL.

Examiner

RYAN D. DONLON

Art Unit

3695

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. §112 first paragraph rejection of claims 80-82 and 84.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 80-82, 84, 86 and 88.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Thu Thao Havan/
Primary Examiner, Art Unit 3695

CONTINUATION SHEET

Response to Arguments

1. Applicant's arguments filed 10/21/2009 have been fully considered but they are not persuasive.
2. Regarding the 35 U.S.C. §112 first paragraph rejection of claims 80-82 and 84, this rejection is hereby withdrawn. The amendment in question was to amend the genus "tax payment status" to the species "unemployment insurance tax payment status" in the stated claims. This amendment was rejected as new matter because Applicant's specification does not contain exact language support for, nor did it appear that the newly amended limitation was required by the specification under the reasoning that "it must be shown that a person of ordinary skill in the art would have understood, at the time the application was filed, that the description requires that limitation". *Hyatt v. Boone* 47 USPQ2d 1128. The Examiner further notes possession of the invention must be shown by the written description and "does not extend to subject matter not disclosed but that would be obvious over what is expressly disclosed". *Lockwood v. American Airlines Inc.* 41 USPQ 1961. However, the MPEP §2163 states "[w]hile there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure". In light of Applicant's arguments, implied support in the specification (e.g. "The [Unemployment Insurance] benefit data includes a benefit status of a claimant and the [Unemployment Insurance] tax data includes a tax payment status of an employer associated with the claimant") and lack of support for any other tax species, it is the Examiner's position that the specification implies that the [Unemployment Insurance] tax data includes an unemployment insurance tax payment status.
3. With respect to Applicant's arguments regarding *Micciantuono*, GAO and Kahn, the Examiner has pointed out where each of the elements of the Applicant's claims are shown in the prior art and has given reason why combining them would have been obvious. The applicant has fails to describe why the combination fails to disclose the claims or why combining the references would not have been obvious. Rather the Applicant has applied a piecemeal analysis of these references. The Examiner notes, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore Applicant's arguments are not persuasive.